

REMARKS/ARGUMENTS

Claims 1-9 and 18-20 are now active in this application. Claims 10-17 are withdrawn from consideration as being directed to a non-elected invention.

The indication that claim 8 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 1-7, 9 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zingher et al. (USPN 5,930,468).

The rejections are respectfully traversed.

Legal precedent is well developed with respect to 35 U.S.C. § 103. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 USPQ 459, 465 (1966), obviousness under 35 U.S.C. § 103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The PTO is thus charged with the initial burden of identifying a source in the applied prior art for: (1) claim features; and (2) the realistic requisite motivation for combining applied references to arrive at the claimed invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999).

Thus, an Office Action rejection must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988);

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

The Examiner should recognize that even if the prior art *could* be modified so as to result in the combination defined by the claims, the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

In this regard, what may or may not be known in general does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). The requisite motivation is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art, at the time the invention was made, to modify a reference in a specific manner to arrive at a specifically claimed invention with a reasonable expectation of achieving a specific benefit. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989).

It is submitted that the Examiner has not met these criteria with respect to Zingher et al for any of the claims under rejection. The question is not what one having ordinary skill in the art could or could not do, but: *why* would one having ordinary skill in the art have been realistically impelled to deviate from the express teachings of the prior art to arrive at the claimed invention? *Gentry Gallery v. Berkline*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

In the Office Action, the Examiner states on page 2, under item 4, with respect to claim 1 that “Zingher et al. discloses ... a decision portion (EPROM) for deciding a state of the image data of the received job; and a controller (microprocessor) for setting a parameter for the

received job in accordance with the state that is decided by the decision portion or setting the parameter that was used in the last job despite the state that is decided by the decision based on a predefined period of time”. However, the Examiner then states at the top of page 3 that “Zingher et al. does not directly teach that the controller sets a parameter in accordance with the state that is decided by the decision portion” which contradicts the previous assertion by the Examiner.

The Examiner admits further that Zingher et al. does not directly teach setting “the parameter that was used in the last job by comparing an interval between the received job and the last job with a predetermined time.” The Examiner states also, “However, Zingher et al. teaches a sequence of printing jobs wherein the controller compares the contents of the images according to a program stored in the EPROM to decide to change the printing form or not. If the contents of the images are different, the printing form of a previous printing job has to be changed to a new printing form for the next printing job, *if the contents of the images of the printing job are the same, there is no need to change the printing form for the next printing job (Fig. 4)*” (emphasis added).

The emphasized portion evinces that the Examiner is not correctly recognizing just what Zingher et al. is doing, as the content of the images of one print job being the same as another print job would not occur on purpose since the function of the printing device in Zingher et al. is to print the different print contents B.1 to B.5, each printing of which is a different print job. Any number of printed outputs can be made using the printing forms D.1 to D.5 so that if more than one output of any one of print contents B.1 to B.5 was to be made, a user would not reload the print content to be printed, but merely instruct that the necessary plurality of outputs of the specific print content be printed by the printing machine shown, for example, in FIG. 3.

As disclosed in Zingher et al., multiple print jobs are to be carried out and in the example disclosed in the reference, five individual image contents B.1 to B.5 are first fed in into data processing device DV to perform 5 print jobs. It is noted that Zingher et al. never describes anything about continuously feeding image contents that are to be ultimately printed. More specifically, in order to carry out the methodology described in Zingher et al., there needs to be a finite number of individual image contents fed into the data processing device DV. The five individual image contents are fed into data processing device DV in any order.

Referring to column 7, line 66 to column 8, line 39, in order to actually perform printing of the individual image contents, each of individual printing forms D.1 to D.5 has to be generated. This is done by a printing form generating device DE, assigned to the to a printing form cylinder D. Printing form generating device DE is connected to the data processing device DV and receives the individual image information necessary for writing the printing form. Next, the printing form is inked onto the printing form cylinder D and the printed image is then transferred by means of a blanket cylinder G onto the sheet-like material to be printed.

The point of Zingher et al. is to optimize the individual pixel-by-pixel rewriting process that is performed by the data processing device DV when producing the printing forms D.1 to D.5 from the image contents B.1 to B.5. Optimization can be in terms of time, in terms of the process, and or in terms of economy of materials, so that the lowest possible number of pixel-by-pixel rewriting processes have to be performed by the data processing device DV (see column 5, lines 8-22). The optimization is done by evaluating the respective image contents B.1 to B.5 and resorting the sequence in which they were fed in into an optimized printing sequence that provides the lowest possible number of pixel-by-pixel rewriting processes that have to be performed by the data processing device DV.

In view of such disclosure, it should be quite clear to any person of ordinary skill in the art that the time between entering each of the image contents B.1 to B.5 (entering each of the image contents B.1 to B.5 corresponds receiving a job for the printing device of Zingher et al.) to the printing device of Zingher et al. is not relevant in Zingher et al. The reason it is not relevant is that it has no bearing upon providing the lowest possible number of pixel-by-pixel rewriting processes that have to be performed by the data processing device DV to provide all of the printing forms D.1 to D.5 that are to be used in printing the image contents B.1 to B.5. Furthermore, if such time were used in deciding what printing form D to use, as suggested by the Examiner, it would be antithetic to the objective in Zingher et al. of providing the lowest possible number of pixel-by-pixel rewriting processes that have to be performed by the data processing device DV to provide all of the printing forms D.1 to D.5.

Furthermore, if such time were used to somehow decide not to change the printing form, as suggested by the Examiner, there would be an inking of the same printing form onto the printing form cylinder D that was previously inked and a duplicate printed image would then be transferred by means of a blanket cylinder G onto the sheet-like material to be printed. It is unclear from the Examiner's imaginative analysis what would happen to the image content that is entered within the required predetermined time interval, as the Examiner's analysis says that the image form does not change, but of course such image content in almost every case is different from that of the previous image content. The net result would be reprinting using the previous printing form corresponding to a specific image content instead of the different image content that should be used to print, a totally implausible and unacceptable result.

Simply put, there is no realistic motive for one having ordinary skill in the art to compare the interval between the entering of a previous entered image content B (previous received job) with

the currently entered image content B (currently received job) in order to decide whether or not to use the same printing from as was previously used since such time differential has no realistic association with making a decision as to whether or not the image contents are the same. In this regard, it should be clear to any person of ordinary skill in the art also that the print forms D cannot be realistically equated to the claimed parameter for a received job, as has been done by the Examiner in the current Office Action.

In view of the above, the only apparent motivation of record for the modification of Zingher et al. proposed by the Examiner to arrive at the claimed inventions is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987). It is, therefore, respectfully submitted that the Examiner has not established the requisite motivation for the proposed combination of references to arrive at the claimed invention.

It is not apparent wherein Zingher et al. discloses or suggests that the decision portion decides whether the image data of the received job are data within a predetermined color range (claim 2). The Examiner refers to column 3, lines 8-23, column 4, lines 52-53 and column 8, lines 29-33 and 55-64. However, column 3, lines 8-23 describes comparing the image contents of the respective color separations and the image contents of the color separations of the respective print *jobs with one another pixel by pixel*, which does not decide whether the image of the received job are data within a predetermined color range. Column 4, lines 52-53 merely describes that five print jobs are to be carried out in a single color and will have respective image contents of the entry sequence B.1, B.2, B.3, B.4, B.5, which does not decide whether the image of the received job are data within a predetermined color range. Column 8, lines 29-33 describe

point-by-point comparison of the image contents and in the case of two-color, three-color or multicolor print jobs, the image contents of the individual colors (following a color separation) are also compared with one another pixel by pixel for use in the re-sorting process, not deciding whether the image of the received job are data within a predetermined color range. Column 8, lines 56-54 describes that by means of the data processing device DV according to a further embodiment of the invention, the ink demand of the printing forms can be determined from the image contents, as by means of the known plate scanners, in order to define the proportions of printing areas, so that the readjustment times resulting therefrom can also be taken into account during the definition of the job sequence which is then to be-executed. This also has nothing to do with deciding whether the image of the received job are data within a predetermined color range.

Column 6, lines 1-52 and column 8 lines 56-64 of Zingher et al. have nothing to do with an image processor performs a color compression of the image data of the received job in accordance with the set parameter (claim 3), the decision portion performs the decision for the image data of all pages included in the received job (claim 4) or the image processor performs the color compression of the image data of all pages included in the received job in accordance with the set parameter when it is decided by the decision portion that image data of at least one page are out of the predetermined color range (claim 5).

The Examiner refers to the RAM of Zingher et al. as memorizing a parameter set by the controller along with the control information and a user interface (I/O) for selecting operation of the parameter. However, there is no description in Zingher et al. that the RAM memorizes a parameter set by the controller along with the control information thereof and the controller sets the selected parameter to the image processor when the selecting operation is performed by a

user interface for selecting operation of the parameter memorized in the memory (claim 6).

Columns 3, lines 8-28, column 3, line 66 to column 4, line 17, column 5, lines 27-41 and column 8, lines 53-64 of Zingher et al. do not disclose or suggest anything about the controller sets a specific parameter to the image processor when a predetermined time passed after the end of the job (claim 7), the specific parameter is a parameter that has the largest set frequency among the parameters memorized in the memory (claim 8) or that the predetermined time is variable (claim 9).

As noted by the Examiner, claims 18-20 are method claims of apparatus claims 1-7 and 9. Since Zingher et al. does not disclose or suggest the subject matter recited in claims 1-7 and 9, Zingher et al. does not disclose or suggest the subject matter recited in claims 18-20.

In summary, it is submitted that the Examiner has not established that a person of ordinary skill in the art would have been motivated to modify the express teachings of Zingher et al. in order to meet the terms of the claims. Improper hindsight considerations of the present disclosure cannot be a basis for providing specific structure of a purported obvious modification. Consequently, claims 1-7, 9 and 18-20 are patentable over Zingher et al. and their allowance is respectfully solicited.

CONCLUSION

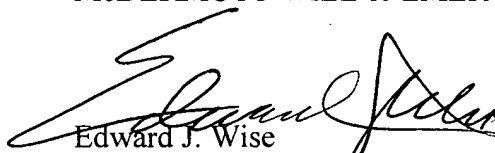
Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

Application No.: 09/662,819

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 EJW:cac
Facsimile: 202.756.8087
Date: August 1, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**